

No. 13490

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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ROSCOE FOWLER,

*Appellant,*

*vs.*

VICMAR SALES COMPANY, VICTOR M. CARTER and MOR-  
RIS J. HALOPOFF,

*Appellees.*

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REPLY BRIEF OF APPELLANT.

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## REPLY BRIEF OF APPELLANT.

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Defendants' brief purports to advance a number of grounds in support of the decision below. Actually, however, the various points are largely repetitions of other points differently stated, none of which are supported in the record.

Defendants admit (Br. p. 17) that their prior art patents are not particularly pertinent, and at (Br. p. 33) they explain why. Defendants' statement in this regard that "The Wolf patent shows only *pivot* hardware" is particularly illuminating in view of defendants' reliance on *pivot* hardware elsewhere in their brief.

The points raised in defendants' brief will be treated *seriatim* using defendants' lettering for identification.

## Part I.

### A.

Contrary to defendants' assertion, the joint Fowler-Murphy patent 2,523,207 is not prior art, since it was copending with the patent in suit. Furthermore, the joint patent is not material since it is directed to an entirely different invention and shows no solution of the problem solved by the patent in suit. The weakness of defendants' over-all position is clearly demonstrated by their reliance on this joint patent as an alleged defense.

Of the cases relied on by defendants (Br. pp. 10-13) as authority for this procedure, *International Seal v. Brooks*, and *Permo v. Hudson-Rose* have no relevance here whatsoever since they did not involve co-pending applications of the inventor of the patent in suit. In the *International* case, Keidel, the sole inventor of the patent there in suit was not a co-inventor of the joint patent of Klein and Kasanof. The same was true in the *Permo* case. The joint inventors of the reference patent were strangers to the patent in suit and the only issue was priority of invention between the joint inventors of the one patent and the sole inventor of the other.

The *Denaro v. Maryland* case was not a Court of Appeals decision as stated in defendants' brief (p. 12), but was a District Court decision wherein the Trial Judge said that the plaintiff was not entitled to be treated as the sole inventor of the joint patent. The *Kendall v. Tetley* case involved a situation where a sole inventor of a basic idea in fabric later filed a joint application with another for using the fabric for tea bags and the Court held that the earlier filed sole patent had exhausted the inventive concept.

*Dwight & Lloyd v. Greenawalt* was a case where Dwight obtained a sole patent on an invention made by him jointly with another. The same invention was involved in both the joint and sole applications, and the Court held that the earlier anticipated the later. Obviously, Dwight was not entitled to two patents on the same invention.

The defendants apparently seek to bring themselves under the rule of *Milburn v. Davis-Bournonville*, 270 U. S. 390, which holds that as between two patents issuing to different persons on the same invention, the patent having the earlier filing date can be cited against the later patent on the question of who is the first inventor.

However, defendants clearly have not sustained their burden of proving that someone else was the first inventor of the combination claimed in the Fowler patent in suit by merely showing that some of the elements of the claimed combination are also shown in a co-pending but later issued Fowler joint patent. This obviously does not prove that someone else, presumably plaintiff's employee Murphy, was the first inventor of the combination claimed in the patent here in suit. Defendants have made no effort to sustain their burden of proving that Murphy invented or contributed any of the elements which are common to the two patents, absent which they are not entitled to rely on said joint patent as prior art.

Furthermore, even if the Fowler joint patent could be considered part of the prior art, still it has no probative effect here, since it is not for the same invention as the patent in suit. The *Milburn v. Davis-Bournonville* case makes it quite clear that the earlier filed application must not only be by a stranger, but must also anticipate, *i. e.*, must disclose the entire invention claimed in the patent



in suit. Here also, defendants' proofs fail to sustain their position. There is no anticipation and there is no double patenting.

Defendants' statement that the claims in suit are anticipated by the Fowler joint patent is simply not correct.

As pointed out in our Opening Brief, pages 43, 44, the hardware of the joint patent is entirely different in purpose and function from that covered by the patent in suit. The essence of the joint patent is the positioning lever 14 to which the cantilever arm 15 is pivotally attached to give a peculiar jackknife linkage useful where almost no head-room is available.

As distinguished from this, the structure of the patent in suit has no positioning lever at all, but instead pivots the cantilever arm directly to the jamb bracket, as specifically set forth in element (e) of claim 1, quoted on page 9 of defendants' brief. In the jackknife linkage of the joint patent the adjustability of the power and cantilever arms is for a totally different purpose and is not covered by the claims in suit.

The plaintiff here is not claiming to be the inventor of the individual elements *per se* of his patented structure, but only of his novel combination of those elements to produce a demonstrably and admittedly better structure. Defendants' attempt to twist the claims in suit to read on the Fowler joint patent is clear proof of the novelty of plaintiff's structure here in suit.

#### B, C. D.

Sections B, C and D, pages 13-25 of defendants' brief all deal with the same subject matter, all being directed to uses and publications alleged to be prior to plaintiff's invention. These were fully discussed in our opening



brief wherein it was pointed out that not one of the alleged prior uses or publications shows plaintiff's combination of elements, and more specifically not one shows plaintiff's method of adjusting the door.

Defendants' Plate A purports to summarize the alleged prior uses stated by defendants (Br. p. 17) to be their "most pertinent prior art."

However, of the four types of hardware shown in Plate A, those illustrated in Figs. 1 and 3 show no adjustment of the door at all, and Figs. 2 and 4 admittedly do not show plaintiff's means of adjustment. Fig. 2 does not correctly illustrate the McFadden hardware of Exhibit N, and the Winchel and Martlin-Murphy types of hardware, Exhibits R, L and J illustrated in Fig. 2, not only employ different adjusting means but were not proved to be prior to plaintiff's invention.

The Tavart hardware shown in Fig. 4 and discussed at page 13 of defendants' brief, is clearly different from plaintiff's hardware since it adjusts the door not by adjusting the cantilever arm, but by moving the pivot pin of the arm from one position to another in a slot in the jamb bracket. The obvious disadvantages of this approach to the problem were fully discussed in our opening brief.

Defendants by their discussion of Plates A and B, infer that the issue of this case concerns solely the *location* of the means for adjusting the door. By thus contending, they seek to divert attention from the real issue which is the particular means used and its interrelationship with the other elements of the claimed structure.

We concede that other and different means located at other and different places are shown in other hardwares for adjusting the position of the door, but those other

means are all outside the claims of plaintiff's patent. We are concerned here only with the structural combination shown and claimed in the patent in suit, and deliberately copied by defendants.

If defendants think so highly of these other structures with their different means of adjusting the door, why did they not copy one of them, instead of plaintiff's precise structure with its particular means of adjustment?

Defendants make much of the simplicity of plaintiff's invention and seek to belittle his invention by saying that all plaintiff did was to substitute this for that, omit parts, change locations of parts, and so on. The best answer to these familiar tactics common to all deliberate infringers who meticulously copy the patentee's claimed structure was given by this Court in the recent case of *Patterson-Ballagh v. Moss*, 96 U. S. P. Q. 206, decided January 27, 1953, in which the Court answered a similar attack made by the defendant there by saying:

"It is quite apparent that simplicity alone will not preclude invention. Hindsight tends to color the seeming obviousness of that which in fact is true contribution to prior art. 'Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention.' *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 435 (1911)."

There as here the defendant was quick to recognize the merit of the patented device over other devices available to it on the market and previously used by it. There as

here the patent in suit was admittedly a narrow patent in a crowded art, but it, like the patent here, solved a real problem. And there as here, the defendant came into Court with various and sundry reasons why the Patent Office should never have granted the patent. However, this Court unequivocally rejected these various contentions of defendant, saying:

“Appellants had the burden of proof on the question of the validity of the Moss patent since a presumption of validity arises from the issuance of a patent. *Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171 (33 U. S. P. Q. 247, 248-249) (1937); *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 293 U. S. 1, 7 (21 U. S. P. Q. 353, 355) (1934). Reasonable doubt must be resolved in favor of the validity of the patent. The presumption created by the action of the Patent Office is the result of the expertness of an administrative body acting within its specific field and can be overcome only by clear and convincing proof. \* \* \*

The holding in the *Kwikset* case cited in defendants' brief is not in conflict with this Court's decision in the *Moss* case, nor with plaintiff's position in this case, for we have here no question of merely aggregating or accumulating old elements as was the situation in *Kwikset*, but on the contrary, we have here a real and novel combination in the truest sense of the word, where all of the elements co-act to produce a new and better result, just as in the *Moss* case.

#### E.

Recognizing the weakness of their position in attempting to rely upon the joint Fowler-Murphy patent to defeat the Fowler patent in suit, the defendants sought to bolster

this alleged defense by testimony that the structure shown in the joint application was made and sold more than a year prior to the patent in suit and was therefore a statutory bar.

To accomplish this they produced the witness McFadden who had worked for plaintiff for three months in 1946 [R. 125], six years prior to the trial, to testify on the subject. That McFadden in 1952 was thoroughly confused both as to what the drawings of the joint patent showed, and as to what products were being sold by Fowler in 1946, as distinguished from what was being experimented on, is clear from his testimony as a whole.

In his colloquy with the Court, McFadden tried to bring out that the structure being sold in 1946 was not adjustable to plumb the door, but did, he thought, have two limiting positions defined by spaced holes, so that it could be differently balanced for different sized, seven foot and eight foot doors. This was clarified by McFadden on page 141 of the record, last four lines, where he said

“Yes. That was put in there for that purpose, but not to make a vertical adjustment on the door. This has nothing to do with making vertical adjustment on the door.”

And also see pages 142 and 143 of the record.

Later in discussing McFadden's own hardware [Ex. N] made after he left Fowler's employ, the Court asked [R. 148]:

“Why didn't you ever use the slotted arm? You knew of the slotted arm door,”

and the witness replied:

“Not at the time I made this, I did not know of the slotted arm,”



which clearly shows that whatever it was that McFadden worked on at Fowler's plant in 1946, it certainly was not a slotted arm.

Subsequently, McFadden independently went out and checked some early Fowler jobs to see if he had been correct in his former testimony concerning what Fowler had sold in 1946. Before the trial was concluded, McFadden came back voluntarily and testified that part of his earlier testimony had been in error. At R. 253, McFadden unequivocally stated that the cantilever arm on the Fowler Lo-Head hardware sold in 1946 was not adjustable.

“A. It was not made in two pieces.”

And with respect to the two-piece arm, that [R. 254]:

“A. We had it for experimental purposes. None of them were sold.”

On pages 254 to 260, McFadden fully explained how and why he had checked up on his earlier statements and why he wanted to put the record straight.

“I found out afterwards that it was not correct, and I wanted to correct it.” [R. 260, top of page.]

It is apparent therefore that defendants' quotation on page 27 of their brief from McFadden's testimony tells only a part of the story—a part which was repudiated by McFadden after he had an opportunity to check up on the facts.

McFadden's corrected testimony with respect to what was sold in 1946 was fully corroborated by Fowler at R. 170, 171.

F.

This section of defendants' brief has no basis in fact and the point attempted to be made is fallacious and irrelevant on its face. Plaintiff did not conceal or suppress the drawing in question or any other evidence.

In the first place, Fowler volunteered information concerning the drawing Exhibit P [R. 150], and later a copy was given to defendants' counsel in open court [R. 157, 158].

“Mr. Fulwider: We have a copy here you are very welcome to have, if you had just asked for it.”

In the second place, the drawing states on its face that it is of “Olympic” hardware, which is the name used by defendants for hardware purchased from plaintiff—and the first such purchase was in 1949. The date of 1948 on the drawing therefore is obviously in error, since there was no such thing in 1948 as “Olympic” hardware made by plaintiff. The testimony of Carvel Moore [R. 237-52] clearly explains that the number 491 on the drawing indicated that the drawing was made in 1949.

Furthermore, there is no evidence of any sales of said hardware by plaintiff in 1948, and therefore if the date on the drawing was correct, it would do nothing more than carry plaintiff's date of invention back several months to a time in 1948. If anything, this would be helpful to plaintiff's case, not detrimental to it. Defendant asserts that the drawing was material. But nowhere does defendant tell us how it was material.

All of the hullabaloo at the trial, and defendants' discussion in their brief concerning Exhibit P, was and is, merely a smoke-screen to try and becloud the issues. It has absolutely nothing to do with the merits of the case, or plaintiff's conduct thereof. It is a “red-herring,” pure and simple.

G.

In this section, defendants after pointing out that patents showing adjustable arms in "pivot" hardware are not pertinent to the issues here, assert that if the Examiner had had the defendants' "prior uses" before him, he would not have issued the patent in suit. Taking these so-called "uses" in the order named by defendants (Br. p. 34) we see that they could not possibly have changed the Examiner's thinking.

Exhibits B-1 and B-5, illustrating Standard and Lo-Head respectively, show no means at all of adjusting the door. The Tavart hardware, Exhibits C-1 and D, are the same as shown in the Smith patent, Exhibit T, which was co-pending with the patent in suit and which the Examiner did not think close enough to put in interference with plaintiff's patent. The only adjustability shown in the Coffey hardware of Exhibit C-4 is in the "pivot" set in the left-hand photo. No adjustment at all is shown for the jamb hardware in the other photo. Winchel's hardware, Exhibit J, was not proved to be prior to Fowler and besides it adjusts by having a slot in the door rail in which a pivot pin is slid. McFadden, Exhibit N, is similar to Winchel but more complicated, and likewise different from plaintiff's hardware.

Certainly, none of these so-called "prior uses" could have carried any weight at all with the Examiner. They merely represent a series of abortive efforts on the part of persons skilled in the art to solve the problem first successfully solved by plaintiff. They are merely cumulative failures now put forward by defendants as meritorious ideas in defendants' attempt to discredit plaintiff's invention. Again we ask, if these other hardwares solved the problem, why did not defendants copy them instead of plaintiff's?



## Part II.

Defendants attempt to excuse their copying and other unfair trade tactics on the ground that plaintiff's patent had not issued when defendants first started said unfair practices. This is beside the point. The practices were just as unfair before the issuance of plaintiff's patent as they were after its issuance.

The secondary meaning which attached to plaintiff's hardware was not because of the patent, but arose because of the novelty of its construction and appearance. All of the door hangers called by plaintiff as witnesses testified unequivocally that plaintiff's hardware was distinctive in appearance and called plaintiff to mind as the source of said hardware whenever they saw it.

Nothing more need be said in reply to this part of defendants' brief. It is amply refuted in plaintiff's opening brief.

### Conclusion.

Defendants' protestations to the contrary, the evidence is clear that defendants deliberately copied the precise hardware defined by the claims of the patent in suit, which was duly and legally issued to plaintiff for his invention. The judgment below should be reversed and the case remanded for an accounting and the issuance of an injunction against further infringement.

Respectfully submitted,

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